

By



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,010	07/28/2003	Daniel Shapiro	109909-133501	7626

25943 7590 07/12/2005

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

PHAM, TUAN

ART UNIT PAPER NUMBER

2643

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,010	Applicant(s) SHAPIRO ET AL.	
	Examiner TUAN A. PHAM	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,12-21 and 30-34 is/are rejected.
- 7) ☒ Claim(s) 3-11, and 22-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/908,118.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/1/04, 9/10/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 3/1/2004 and 9/10/2004 has been considered by Examiner and made of record in the application file.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 48 and 56 of copending Application No. 10/334,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 in the constant application has the same scope of claimed invention with obvious wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Murray et al. (Pub. No.: US 2003/0087664, hereinafter, "Murray").

Regarding claim 19, Murray teaches a wireless mobile communication device, a method of operation comprising: entering a first functional mode of operation (see col.1, [0009-0013], cellular mode); facilitating user communication with another user of another communication device, using the wireless mobile communication device, during the first functional mode of operation (see col.1; [0009-0013]); entering a second

functional mode of operation (see col.1, [0009-0013], dispatch mode); and emitting at least one light pulse from the wireless mobile communication device, during the second functional mode of operation (see col.1, [0009-0015]).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 1-2, and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molinaroli (U.S. Patent No.: 6,265,984) in view of Murray et al. (Pub. No.: US 2003/0087664, hereinafter, "Murray").**

Regarding claim 1, Molinaroli teaches a wireless mobile communication device comprising (see col.7, ln.67): a body casing defining an interior space, and having a

Art Unit: 2643

photonic opening (see figure 1, case); first one or more light sources (LS) disposed in the defined interior space to contribute to outputting a first light pulse through the photonic opening of the body casing (see figure 2, plurality of LED 12, col.3, ln.40-60).

It should be noticed that Molinaroli fails to teach a transmit/receive section to transmit and receive communication signals, when selectively activated/deactivated in one or more operational modes, the first one or more LS being directly or indirectly optically aligned with the photonic opening of the body casing, to facilitate emitting of the first light pulse, during the one or more operational modes; storage medium having instructions stored therein designed to selectively activate/deactivate the one or more LS to contribute to outputting the first light pulse; and a processor coupled to the one or more LS and the storage medium to execute the instructions during the one or more operational modes. However, Murray teaches such features (see figure 1, figure 3, LED 108, RF 304, controller 302, [0009-0015]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Murray into view of Molinaroli in order to display the message to the user as suggested by Molinaroli at column 1, lines 23-35.

Regarding claim 2, Molinaroli further teaches the wireless mobile communication device of claim 1, wherein the instructions are designed to maintain at least a first of the one or more LS in an activated state, to enable the wireless mobile communication device to be used as a light pointer, during a pointer operational mode (see figure 1, on position, col.3, ln.40-50).

Regarding claim 12, Molinaroli further teaches the wireless mobile communication device of claim 1, where at least one of the first one or more light sources comprises a laser diode (see col.7, ln.47-50).

Regarding claim 13, Molinaroli further teaches the wireless mobile communication device of claim 1, where the first one or more light sources comprise a first, a second, and a third laser diode to output light pulse in a red, a green, and a blue spectrum respectively, and the wireless communication device further comprises a plurality of mirrors disposed in the defined interior space, between the photonic opening and the first one or more light sources to integrate the outputted light pulses in the red, blue, green spectrums to contribute to the forming of the first light pulse (see figure 1, col.6, ln.43-67).

Regarding claim 14, Molinaroli further teaches the wireless mobile communication device of claim 1, wherein the wireless mobile communication device further comprises second one or more LS to contribute to outputting a second light pulse, the photonic opening being also optically aligned with the second one or more LS to facilitate emitting of the second light pulse (see figure 2, LED 12, col.3, ln.32-67).

Regarding claim 15, Molinaroli further teaches the wireless mobile communication device of claim 1, wherein the wireless mobile communication device further comprises second one or more LS to contribute to outputting a second light pulse, and a plurality of mirrors optically aligned with the first and second one or more LS and the photonic opening to facilitate emitting of the second light pulse (see figure 2, LED 12, col.3, ln.32-67).

Regarding claim 16, Molinaroli further teaches the wireless mobile communication device of claim 1, wherein the wireless mobile communication device further comprises a small range diffuser complementarily disposed at least a selected one of said first one or more light sources and said photonic opening, to narrowly diffuse the first light pulse (see figure 2, LED 12, col.3, ln.32-67).

Regarding claim 17, Molinaroli further teaches the wireless mobile communication device of claim 16, wherein the small range diffuser comprises a small range diffusion lens disposed at the photonic opening (see figure 2, LED 12, col.3, ln.32-67).

Regarding claim 18, Molinaroli further teaches The wireless mobile communication device of claim 1, wherein the wireless mobile communication device is a selected one of a wireless mobile phone and a personal digital assistant equipped with wireless mobile communication capability (see figure 2, LED 12, col.3, ln.32-67).

9. Claims 20-21, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al. (Pub. No.: US 2003/0087664, hereinafter, "Murray") in view of Molinaroli (U.S. Patent No.: 6,265,984).

Regarding claim 20, Murray teaches a wireless mobile communication device, a method of operation comprising: entering a first functional mode of operation (see col.1, [0009-0013], cellular mode); facilitating user communication with another user of another communication device, using the wireless mobile communication device, during the first functional mode of operation (see col.1, [0009-0013]); entering a second

functional mode of operation (see col.1, [0009-0013], dispatch mode); and emitting at least one light pulse from the wireless mobile communication device, during the second functional mode of operation (see col.1, [0009-0015]).

It should be noticed that Murray fails to teach said emitting of at least one light pulse comprises selectively activating/deactivating first one or more light sources (LS) to contribute to outputting a first light pulse. However, Molinaroli teaches such features (see figure 1, on/off state, col.3, ln.32-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Molinaroli into view of Murray in order to display the message to the user as suggested by Molinaroli at column 1, lines 23-35.

Regarding claim 21, Molinaroli further teaches the method of claim 20, wherein said selective activation/deactivation of the first one or more light sources (LS) comprises maintaining at least a first of the one or more LS in an activated state, to enable the emitted first light pulse be used as a light pointer (see figure 1, on/off state, col.3, ln.32-67).

Regarding claim 30, Molinaroli further teaches the method of claim 19, wherein the method further comprises integrating a first, a second, and a third light pulse of a red, a green, and a blue spectrum respectively to form one of the at least one light pulse (see col.6, ln.43-67).

Regarding claim 31, Molinaroli further teaches the method of claim 19, wherein said emitting comprises emitting at least a first and a second light pulse.

Regarding claim 32, Molinaroli further teaches (see col.6, ln.43-67).

Regarding claim 33, Molinaroli further teaches the method of claim 31, wherein said emitting comprises selectively activating/deactivating first and second one or more light sources (LS) to output a first and a second light pulse, with the outputted first and second light pulses being directed at a first and a second mirror respectively; reflecting the first and second light pulses by the first and second mirrors to emit the first and second light pulses (see col.6, ln.43-67).

Regarding claim 34, Molinaroli further teaches the method of claim 19, wherein the method further comprises narrowly diffusing the at least one light pulse being emitted (see col.6, ln.43-67).

Allowable Subject Matter

10. Claims 3-11, and 22-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Munyon (U.S. Patent No. 5,973,607), Lee (U.S. Patent No. 5,800,039), Crouch (U.S. Patent No. 6,037,876), and Tokimoto et al. (U.S. Patent No. 5,670,971) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s).

Art Unit: 2643

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (571) 272-7499 and

IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (571) 272-2600 FOR THE SUBSTITUTIONS OR COPIES.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2643
July 6, 2005
Examiner

Tuan Pham


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600